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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/986,070	11/07/2001	Takashi Okada	381NP/50632	4733

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EXAMINER

PAREKH, ANKUR

ART UNIT	PAPER NUMBER
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3681

DATE MAILED: 03/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/986,070

Applicant(s)

OKADA ET AL.

Examiner

Ankur Parekh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 17-61 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-6, 8, 9, 17-24 and 59-61 is/are allowed.
- 6) ☒ Claim(s) 7, 10, 11, 25-39, 43, 46 and 49-58 is/are rejected.
- 7) ☒ Claim(s) 12, 13, 40-42, 44, 45, 47 and 48 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. This is the second Office action on the merits of Application No. 09/986,070, filed November 7, 2001. This action is in response to the amendment received December 8, 2003. Claims 1-13 and 17-61 are pending.

#### *Election/Restrictions*

2. Claims 1-3 are generic and allowable. Accordingly, the restriction requirement as to the encompassed species is hereby withdrawn and claims 7, 10-13, and 25-58, directed to the species of Figs. 10 and 15, are no longer withdrawn from consideration since all of the claims to these species depend from or otherwise include each of the limitations of an allowed generic claim.

In view of the above noted withdrawal of the restriction requirement as to the linked species, applicant(s) are advised that if any claim(s) depending from or including all the limitations of the allowable generic linking claim(s) be presented in a continuation or divisional application, such claims may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Once a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. See *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

#### *Claim Objections*

3. Claims 12, 13, and 40-58 are objected to. Each of these claims is drawn to “[a]n automatic transmission.” However, each of these claims recites features that are not a part of the automatic transmission in the relevant disclosed embodiment of the invention. Claims 40-58 recite features found in the embodiment of Fig. 15. In this embodiment the “motor generator” is far removed from the transmission. The “motor generator” drives the rear wheels—the “wheels to which the torque of the transmission is not transferred”—and the automatic transmission transfers the power from the engine to the front wheels. There is no connection between the automatic transmission and the motor generator. Therefore, how can applicant recite that the

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motor generator and the “transferring mechanism” are elements of the automatic transmission?

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 7; 10, 11, 25-39, 43, 46, and 49-58 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 7 and 25-29 recite the limitation "the gear engaged with one of said drive gears fixed to said first axis" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claims 7 and 25-29 further recite the limitation “said gear” in line 7. What specific gear is applicant referring to? There are multiple gears previously recited in each one of these claims. For example, each one of these claims ultimately depends on one of claims 1-3. Each one of claims 1-3 recites at least three gears.

Regarding claims 43, 46, 49-58, each of these claims recites a “motor generator” in line 3. With respect to claims 43 and 46, it is not clear whether applicant is reciting an additional or second motor generator or is simply referring back to the motor generator that is already recited in line 5 of claim 7. With respect to the claims 49-53, it is not clear whether applicant is reciting an additional or second motor generator or is simply referring back to the motor generator that is already recited in line 5 of claims 25-29, respectively. With respect to the claims 53-58, it is not

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clear whether applicant is reciting an additional or second motor generator or is simply referring back to the motor generator that is already recited in line 5 of claims 25-29, respectively (claims 30-34 respectively depend from claims 25-29).

*Allowable Subject Matter*

6. Claims 2-6, 8, 9, 23, 24, 60, and 61 are allowed.
7. Claims 1, 17-22, and 59 were allowed in a previous action.

*Conclusion*

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ankur Parekh whose telephone number is (703) 305-3795. The examiner can normally be reached on Monday through Friday, 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Marmor can be reached on (703) 308-0830. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ankur Parekh  
March 21, 2004